

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

# FEE TRANSMITTAL for FY 2005

Applicant claims small entity status. See 37 CFR 1.27

**TOTAL AMOUNT OF PAYMENT**

(\$ 250)

**Complete If Known**

Application Number	10/684,609
Filing Date	October 14, 2003
First Named Inventor	Richard B. Mindlin
Examiner Name	Michael S. Chambers
Art Unit	3711
Attorney Docket No.	413333

**METHOD OF PAYMENT** (check all that apply)

Check  Credit Card  Money Order  None  Other (please identify) : \_\_\_\_\_

Deposit Account Deposit Account Number: 12-0600 Deposit Account Name: LATHROP & GAGE LC

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below  Charge fee(s) indicated below, except for the filing fee  
 Charge any additional fee(s) or underpayments of fee(s)  Credit any overpayments

Under 37 CFR 1.16 and 1.17

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

<b>Application Type</b>	<b>FILING FEES</b>		<b>SEARCH FEES</b>		<b>EXAMINATION FEES</b>		
	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Fee (\$)</b>	<b>Small Entity</b>	<b>Fee (\$)</b>	<b>Fees Paid (\$)</b>
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

**Small Entity**

Fee (\$) Fee (\$)

50 25

Each independent claim over 3 (including Reissues)

200 100

Multiple dependent claims

360 180

**Total Claims**

**Extra Claims**

**Fee (\$)**

**Fee Paid (\$)**

**Multiple Dependent Claims**

-20 or HP= \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

Fee (\$) Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20.

**Indep. Claims**

**Extra Claims**

**Fee (\$)**

**Fee Paid (\$)**

Fee (\$) Fee Paid (\$)

- 3 or HP= \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<b>Total Sheets</b>	<b>Extra Sheets</b>	<b>Number of each additional 50 or fraction thereof</b>	<b>Fee (\$)</b>	<b>Fee Paid (\$)</b>
- 100 = _____	/ 50 = _____	(round up to a whole number)	x _____	= _____

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

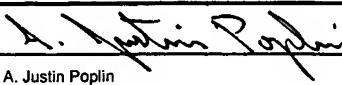
Other (e.g., late filing surcharge) : Filing Appeal Brief

**Fees Paid (\$)**

\_\_\_\_\_

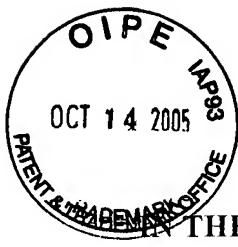
\$250

**SUBMITTED BY**

Signature		Registration No. (Attorney/Agent)	53,476	Telephone	(816) 460-5306
Name (Print/Type)	A. Justin Poplin			Date	October 14, 2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



PATENT

Attorney Docket No.: 413333  
Express Mail Label No.: EV413219232US

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Richard B. Mindlin  
Serial No.: 10/684,609  
Filed: 14 October 2003  
For Method and Apparatus for  
Golf Instruction

Examiner: Michael S. Chambers  
Group Art No.: 3711  
Confirmation No. 2912  
Att'y Docket No. 413333

14 October 2005

**APPEAL BRIEF**

Mail Stop: Appeal Brief-Patent  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

In accord with 37 CFR § 41.37, and fully responsive to the Office Action of 18 October 2004, Appellant hereby files his appeal brief in support of his Appeal in the above-identified matter. A notice of appeal, with appropriate fee of \$250 as required by §§41.31, 41.20(b)(1), was filed on April 18, 2005. The \$250 fee for this appeal brief, as required by 37 CFR §41.20(b)(2), is also filed herewith.

**REAL PARTY IN INTEREST**

The named inventor, Richard B. Mindlin, is the real party in interest.

**RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to appellant or the appellant's legal representative which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**STATUS OF CLAIMS**

Claims 1-13 are pending in the current application. The rejections of claims 1-13 are being appealed.

10/18/2005 RHEBRAHT 000000002 120600 10684609  
01 FC:2402 250.00 DA

## **STATUS OF AMENDMENTS**

No amendment has been filed subsequent to final rejection.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

The claimed disclosures include methods of using golf instructional devices and methods of providing golf instruction.

In the embodiment of claim 1, a method of using a golf instructional device 10 includes the steps of: placing one or more selectively removable and repositionable foot positioning member 12 onto a support mat surface 17 to indicate proper placement of a user's foot or feet for swinging a golf club (specification ¶ 24, 26; page 9, lines 3-12, page 9, line 22 - page 10, line 3); placing a selectively removable and repositionable club positioning member 13 onto the support mat surface 17 to indicate proper pre-swing body and club setup alignment (specification ¶ 24, 29; page 9, lines 3-12, page 10, line 29 – page 11, line 7); placing a mirror 14 adjacent the support mat surface 17 (specification ¶ 30; page 11, lines 17-18); having a user stand on the support mat surface 17 and align one or more feet with the one or more foot positioning members 12 (specification ¶ 26-27; page 9, line 22 – page 10, line 14); having a user position the user's head such that the user can essentially only view his own eyes in the mirror 14 (specification ¶ 30; page 11, lines 8 – 28); and having a user swing a golf club while visually observing any movement of his own head in the mirror 14 during at least a portion of the golf club practice swing (specification ¶ 30; page 11, lines 8-28). The mirror 14 is sized and configured to indicate and maintain proper positioning of the user's eyes during a golf swing (specification ¶ 30, page 11, lines 8-28).

In the embodiment of claim 2, the method of embodiment 1 further includes the step of: adjusting the position of the one or more removable and repositionable foot positioning members 12, removable and repositionable club positioning member 13, or mirror 14 on the support mat surface 17 based on either a specific instructional lesson to be taught by a golf instructor, or on changes and/or improvements in the golf club swing of a user, such adjusting performed only by a golf instructor and not by the individual

using the mat 17. Specification ¶ 30-32, 34-35; page 11, line 8 – page 13, line 6, page 13, line 15 – page 14, line 16.

In the embodiment of claim 3, the method of embodiment 1 further includes the step of: providing the user with an instructional manual containing teaching methods corresponding to specific lessons taught by a golf instructor, such teachings arranged within the manual in a manner as to facilitate the user reinforcing specific pre-swing setup positioning and club swing techniques learned with the instructional device outside the presence of the golf instructor. Specification ¶ 31-35; page 12, line 6 - page 14, line 16.

In the embodiment of claim 4, a method of providing golf instruction includes the steps of: providing a user with an instructional device 10 having selectively removable and repositionable markers 12, 13 for designating proper setup positioning and stance for the user to swing a golf club (specification ¶ 24, 26, 29; page 9, lines 3-12, page 9, line 22 – page 10, line 3, page 10, line 29 – page 11, line 7), the positioning being customized and markers being adjustable for an individual user (specification ¶ 26-30; page 9, line 22 – page 12, line 5); and positioning a user in a proper stance by having a golf instructor position the selectively removable and repositionable markers 12, 13 on the device 10 in such locations as to teach the user a proper setup position for swinging a golf club (specification ¶ 26-31; page 9, line 22 - page 12, line 26).

In the embodiment of claim 5, the method of embodiment 4 further includes the steps of: providing a mirror 14 with the instructional device 10 for monitoring the location of a user's eyes while making practice swings with the golf club (specification ¶ 30; page 11, lines 17-18); and having a golf instructor position the mirror 14 on the device 10 in such a location as to teach the user to maintain a near-steady head while making practice swings with the golf club (specification ¶ 30-31; page 11, line 8 – page 12, line 26).

In the embodiment of claim 6, the method of embodiment 4 further includes the step of: providing a user with an instructional manual containing teaching methods corresponding to specific lessons taught by the golf instructor, such teaching arranged within the manual such that the user can reinforce a specific club swing technique learned

with the instructional device outside the presence of the golf instructor. Specification ¶ 31-35; page 12, line 6 – page 14, line 16.

In the embodiment of claim 7, a method of providing golf instruction in which a user makes practice golf club swings is provided. The embodiment of claim 7 includes the step of placing a removably positionable mirror 14 adjacent to the support mat surface 17. Specification ¶ 30-35; page 11, line 8 - page 14, line 16.

## **GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

I. Does the combination of O'Brien (US 4,164,352) and Florian (US 5,294,124) render claim 1 unpatentable under 35 U.S.C. § 103(a)? Namely, does O'Brien ('352) disclose, teach, or suggest placing a selectively removable and repositionable club positioning member onto a support mat surface; does Florian ('124) disclose, teach, or suggest placing adjacent a support mat surface a mirror that is sized and configured to indicate and maintain proper positioning of a user's eyes during a golf swing; does Florian ('124) disclose, teach, or suggest having a user position the user's head such that the user can essentially only view their eyes in a mirror?

II. Does the phrase "placing a mirror adjacent the support mat surface" in claims 1, 7, and 8 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph? Though the examiner only raised this rejection for claims 7 and 8, claim 1 uses identical language.

III. If claims 1, 7, and 8 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, does the phrase "mirror on the support mat surface" in claim 2 clarify or limit the meaning of the phrase "mirror adjacent the support mat surface" in claim 1 (from which claim 2 depends) so that a § 112 rejection is not appropriate for claim 2?

IV. If the § 112 rejection is not appropriate for claim 2, but if claim 1 is obvious from the combination of O'Brien ('352) and Florian ('124), does the combination of O'Brien (US '352), Florian (US '124), and Durso (US 5,141,232) render claim 2 unpatentable under 35 U.S.C. § 103(a)? Namely, do these references disclose, teach, or suggest the step of adjusting the position of [one or more element] on the

support mat surface based on either a specific instructional lesson to be taught by a golf instructor, or on changes and/or improvements in the golf club swing of a user?

V. If the § 112 rejection is not appropriate for claim 1, but if claim 1 is obvious from the combination of O'Brien ('352) and Florian ('124), does the combination of O'Brien ('352) and Florian ('124) also render claim 3 unpatentable under 35 U.S.C. § 103(a)? Namely, does the cited art disclose, teach, or suggest providing the user with an instructional manual containing teaching methods corresponding to specific lessons taught by a golf instructor, such teachings arranged within the manual in a manner as to facilitate the user reinforcing specific pre-swing positioning and club swing techniques learned with the instructional device outside the presence of the golf instructor?

VI. Does the combination of O'Brien ('352) and Durso ('232) render claim 4 unpatentable under 35 U.S.C. § 103(a)? Namely, does O'Brien ('352) disclose, teach, or suggest providing a user with an instructional device having selectively removable and repositionable markers for designating proper setup positioning and stance for the user to swing a golf club?

VII. If claim 4 is obvious from the combination of O'Brien ('352) and Durso ('232), does the combination of McDevitt (US 6,500,075) and Florian ('124) render claim 5 unpatentable under 35 U.S.C. § 103(a)? Namely, does Florian ('124) disclose, teach, or suggest having a golf instructor position a mirror on a device in such a location as to teach a user to maintain a near-steady head while making practice swings with a golf club?

VIII. If claim 4 is obvious from the combination of O'Brien ('352) and Durso ('232), does the combination of McDevitt ('075) and Latella (US 5,839,968) render claim 6 unpatentable under 35 U.S.C. § 103(a)? Namely, does Latella ('968) disclose, teach, or suggest (1) providing a user with an instructional manual containing teaching methods corresponding to specific lessons taught by a golf instructor and (2) reinforcing a specific user stance and user club swing technique through teaching arranged within the manual outside the presence of the golf instructor; and does the prior art disclose, teach, or suggest (3) the selectively removable and repositionable markers for designating proper

setup positioning and stance for the user to swing a golf club maintaining their positioning during transfer and subsequent setup of the instructional device?

IX. Considering the terminal disclaimer filed concurrently with this Appeal Brief, is claim 13 in condition for allowance?

## **ARGUMENT**

I. Does the combination of O'Brien (US 4,164,352) and Florian (US 5,294,124) render claim 1 unpatentable under 35 U.S.C. § 103(a)? Namely, does O'Brien ('352) disclose, teach, or suggest placing a selectively removable and repositionable club positioning member onto a support mat surface; does Florian ('124) disclose, teach, or suggest placing adjacent a support mat surface a mirror that is sized and configured to indicate and maintain proper positioning of a user's eyes during a golf swing; does Florian ('124) disclose, teach, or suggest having a user position the user's head such that the user can essentially only view their eyes in a mirror?

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The applicant disagrees with the examiner's conclusion that O'Brien ('352) discloses a selectively repositionable club positioning member, and the applicant urges that the prior art references do not teach or suggest all of the limitations of claim 1 as required by Vaeck. The examiner has cited elements 26 or 24 of O'Brien ('352) as a selectively repositionable club positioning member. Page 3, 18 October 2004 Office Action. While the O'Brien ('352) index 26 may be "located on the side of the hitting area toward the golfer" or "on the outside, i.e., whereby the golf ball is between the index and the golfer," (col. 6, lines 3-6) nowhere does O'Brien ('352) suggest that the index 26 is movable. Rather, the index 26 appears to be a fixed object that may be originally located in one of two places and that remains in its original location.

The teeing position 24 of O'Brien ('352) "may comprise a piece of vertically disposed rubber tubing adapted to hold the ball above the surface of the grassy area 22, or, alternatively, the teeing position may comprise plastic or granular composition adapted to receive conventional wooden tees of the type as are used in playing golf." Col. 5, lines 45-51. From this, it is clear that the teeing position 24 is no more than a support for the ball, and as such, the teeing position 24 is no more of a club positioning member than is the ball.

The applicant's club positioning member 13 is much more than this and is separate from the applicant's ball 32; the applicant's club positioning member 13 is able to indicate proper pre-swing and club setup alignment when placed onto the support mat, as required in claim 1 and discussed in paragraph 31 of the applicant's specification as filed. The applicant's ball does not satisfy the "club positioning member" in claim 1 because the applicant's ball 32 cannot indicate proper pre-swing body and club setup alignment as required in claim 1. Similarly, the teeing position 24 of O'Brien ('352) does not have the ability to indicate proper pre-swing body and club setup. As such, the teeing position 24 of O'Brien ('352) is not a "selectively removable and repositionable club positioning member" under claim 1, and O'Brien ('352) does not suggest such a club positioning member. Because of this, O'Brien ('352) does not disclose, teach, or suggest "placing a selectively removable and repositionable club positioning member onto the support mat surface to indicate proper pre-swing body and club setup alignment" as

required by applicant's claim 1. This is a feature that is not found in, suggested by, or obvious from the prior art, and as such, the applicant respectfully urges that the examiner has failed to meet the burden set forth in Clapp and Vaeck.

The applicant further believes that the examiner erred in citing Florian ('124) to reject claim 1 because Florian ('124) does not disclose or suggest using a mirror "sized and configured to indicate and maintain proper positioning of a user's eyes during a golf swing" as required by claim 1. It is clear from paragraph 32 of the specification as filed that to be "sized and configured to indicate and maintain proper positioning of a user's eyes during a golf swing" means that the mirror is "sufficiently small such that when it is placed on the top surface 17 of the mat 11, the user is essentially only able to view their eyes". Because the mirror in Florian ('124) allows a user to observe "whether the putter head remains perpendicular to the target line 14 ... whether his shoulders remain parallel to the target line ... whether his hands remain forward of the club face and essentially coincident with the ball at the point of contact," (col. 3, lines 40-47) in addition to "whether his head remains in proper alignment by keeping his eyes parallel to the target line," (col. 3, lines 47-48), the mirror in Florian ('124) is clearly not "sized and configured to indicate and maintain proper positioning of a user's eyes during a golf swing" as required by claim 1. This is a feature that is not found in, suggested by, or obvious from the prior art, and as such, the applicant respectfully urges that the examiner has failed to meet the burden set forth in Clapp and Vaeck.

Also, for many of the same reasons that the prior art does not disclose or suggest using a mirror "sized and configured to indicate and maintain proper positioning of a user's eyes during a golf swing", the prior art does not disclose or suggest the step of "having a user...position the user's head such that the user can essentially only view their eyes in the mirror" present in claim 1. As the examiner has not cited any reference whatsoever that teaches or suggests the claim 1 limitation of "having a user...position the user's head such that the user can essentially only view their eyes in the mirror," the applicant respectfully urges that the examiner has failed to meet the burden set forth in Clapp and Vaeck.

For each of the reasons above, the applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejections of claim 1 and claims 2-3 which depend therefrom. Claims 1-3 are in condition for allowance, and such is respectfully requested.

**II.** Does the phrase “mirror adjacent the support mat surface” in claims 1, 7, and 8 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph? Though the examiner only raised this rejection for claims 7 and 8, claim 1 uses “adjacent” as well.

The examiner stated on page 2 of the Office Action dated 18 October 2004 that “The term ‘adjacent’ is significantly broader than the term ‘onto’ and implies structure well beyond that disclosed in the applicants disclosure, which includes the claims as originally filed. This term ‘adjacent’ clearly is not supported and presents new matter.”

It is very clear, however, that no new structure is implied by the use of “adjacent”. Instead, “adjacent” modifies or limits the location/position of the mirror. Since it would be seemingly obvious that the applicant could now amend the claim 1 limitation of “placing a mirror adjacent the support mat surface” (as well as the similar limitations in claims 7 and 8 using “adjacent”) to “providing a mirror” (which is more broad than the claimed “adjacent” limitation and identical to the language of claim 5), it should be clear that the issue is not whether the applicant is claiming broader subject matter than to which he has a right. Also, as the examiner stated, the applicant is not attempting to claim more narrow subject matter than to which he has a right. From this, the issue should be whether the applicant has a right to limit or restrict the claim in this particular way to place the scope of this positioning aspect of the amended claim somewhere between the scope of the claim as filed and the scope of a more broad/encompassing claim as filed. The applicant urges that this is clearly acceptable and that this is generally the purpose of claim amendments.

In other words, the applicant suggests that it is clearly acceptable to amend a claim limitation as long as the scope of the amended claim is between the scope of an originally-presented broad limitation (“providing a mirror” here) and the scope of an originally-presented narrow limitation (“placing a mirror onto the support mat surface”)

here). For clarity, Fig. A is included herein. The outer circle of Fig. A represents the scope of the originally-presented broad limitation (of claim 5), and the inner circle of Fig. A represents the scope of the originally-presented narrow limitation (of claims 1, 7, and 8). The shaded area between the outer and inner circles represents subject matter which is only narrower than the scope of the broad limitation but only broader than the scope of the narrow limitation. This shaded area should be available to the applicant without a 35 U.S.C. § 112, first paragraph rejection and should instead be examined for patentability. Though the issue of claim amendment is addressed in a different context in Ex parte Eggert, 67 U.S.P.Q.2d 1716 (Bd.Pat.App. & Interf. 2003), the applicant believes that the above arguments are supported by Eggert.

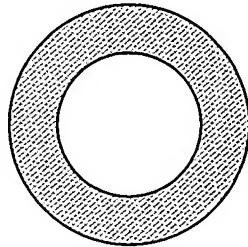


Fig. A

Also, the applicant notes that paragraph 32 of the specification as filed states that “the location of the mirror 14 is set such that the user can view their eyes in the mirror,” and “the mirror 14 may be positioned on the surface 17 of the mat 11”. Nowhere does the specification specifically state or imply that the mirror 14 must be on the mat 11 to be contemplated by the inventor or that the inventor disclaims a similar device/system in which the mirror 14 is not on the mat.

For each of the reasons above, the applicant respectfully requests the withdrawal of the 35 U.S.C. § 112, first paragraph rejections of claims 7 and 8. Claims 1, 7, and 8 are in condition for allowance, along with claims 2-3 and 9-12 which depend therefrom, and allowance is respectfully requested.

III. If claims 1, 7, and 8 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, does the phrase “mirror on the support

mat surface” in claim 2 clarify or limit the meaning of the phrase “mirror adjacent the support mat surface” in claim 1 (from which claim 2 depends) so that a § 112 rejection is not appropriate for claim 2?

Even if claims 1, 7, and 8 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, the phrase “mirror on the support mat surface” in claim 2 sufficiently limits or clarifies the word “adjacent” so that claim 2 requires the mirror to be on the support mat surface. As such, the word “adjacent” in claim 1 does not render claim 2 more broad than the version of claim 2 that was originally filed. Because of this, claim 2 cannot “contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention”; claim 2 fully complies with 35 U.S.C. § 112, first paragraph. At most, claim 2 should only be objected to as depending from a rejected base claim (claim 1), though applicant respectfully emphasizes that claim 1 does fully comply with 35 U.S.C. § 112, first paragraph and that claims 1 and 2 are separately fully allowable.

As the examiner has not entered a rejection under 35 U.S.C. § 112, first paragraph for claim 2, the applicant assumes that the examiner agrees with the applicant’s position. However, since the examiner did not enter a 35 U.S.C. § 112, first paragraph rejection for claim 1—although claim 1 uses the same “adjacent” language rejected to in claims 7 and 8—and did not discuss this issue in relation to claim 2, the applicant believes that it is necessary to clarify this issue.

**IV.** If the § 112 rejection is not appropriate for claim 2, but if claim 1 is obvious from the combination of O’Brien (‘352) and Florian (‘124), does the combination of O’Brien (US ‘352), Florian (US ‘124), and Durso (US 5,141,232) render claim 2 unpatentable under 35 U.S.C. § 103(a)? Namely, do these references disclose, teach, or suggest the step of adjusting the position of [one or more element] on the support mat surface based on either a specific instructional lesson to be taught by a golf instructor, or on changes and/or improvements in the golf club swing of a user?

The examiner stated that “The cited art of claim 2 fails to clearly disclose the use of an instructor. Durso discloses it is well known in the art to use professional when using golf instruction devices (6:51-55).” Page 4, 18 October 2004 Office Action. This is a gross misreading of the applicant’s claim 2 and clearly does not address all of the limitations of the applicant’s claim 2. Namely, this does not address the step of “adjusting the position of [one or more element] on the support mat surface based on either a specific instructional lesson to be taught by a golf instructor, or on changes and/or improvements in the golf club swing of a user”. It is not enough for the examiner to cite a reference disclosing the use of an instructor. Rather, under Vaeck the prior art must teach or suggest all the claim limitations. Not only does the prior art not teach or suggest the applicant’s claimed step, but the examiner has not even fully addressed this limitation. Had the applicant wanted the examiner’s interpretation, the applicant would have included language similar to “providing an instructor” in claim 2 instead of the language that was actually used and cited above. The applicant respectfully asserts that the examiner has failed to meet the burden set forth in Clapp and Vaeck, and the applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claim 2.

V. If the § 112 rejection is not appropriate for claim 1, but if claim 1 is obvious from the combination of O’Brien (‘352) and Florian (‘124), does the combination of O’Brien (‘352) and Florian (‘124) also render claim 3 unpatentable under 35 U.S.C. § 103(a)? Namely, does the cited art disclose, teach, or suggest providing the user with an instructional manual containing teaching methods corresponding to specific lessons taught by a golf instructor, such teachings arranged within the manual in a manner as to facilitate the user reinforcing specific pre-swing positioning and club swing techniques learned with the instructional device outside the presence of the golf instructor?

The examiner stated that “Florian discloses that the use of an instruction manual is well known in the art (1:12-18). Providing a training manual would have been obvious to one of ordinary skill in the art at the time of the invention to have employed an

instruction manual in order to correctly train golfers in the proper foot position and head position.” Pages 3-4, 18 October 2004 Office Action. This completely disregards important limitations of claim 3, namely “containing teaching methods corresponding to specific lessons taught by a golf instructor, such that teachings arranged within the manual in a manner as to facilitate the user reinforcing specific pre-swing setup positioning and club swing techniques learned with the instructional device outside the presence of the golf instructor.” Notably, approximately 47 out of 64 words (roughly 73% of the words) and approximately 5 out of 7 lines (roughly 71% of the lines) of claim 3 simply are not acknowledged or addressed in the examiner’s Office Action.

Once again, the examiner has failed to carry his burden under Clapp and Vaeck. It is not enough for the examiner to cite a reference disclosing the use of an instruction manual, as Vaeck requires that the prior art must teach or suggest all the claim limitations. The claim 3 limitations “containing teaching methods corresponding to specific lessons taught by a golf instructor, such that teachings arranged within the manual in a manner as to facilitate the user reinforcing specific pre-swing setup positioning and club swing techniques learned with the instructional device outside the presence of the golf instructor” are not taught by the prior art, and the examiner has not claimed that these limitations are taught by the prior art. Further, the prior art that the examiner cited in fact does not disclose the use of an instruction manual. Column 1, lines 12-18 of Florian (‘124) are as follows:

movement so as to optimize skill and coordination. To some degree, a participant can improve his skill in a sport by being instructed as to proper body position. However, instruction alone is often of limited assistance. This is because the participant may actually think that he is positioning or moving his body in accordance with the instructions. However, if the participant were

This clearly does not disclose the use of an instruction manual. For all of these reasons, the applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claim 3.

**VI.** Does the combination of O'Brien ('352) and Durso ('232) render claim 4 unpatentable under 35 U.S.C. § 103(a)? Namely, does O'Brien ('352) disclose, teach, or suggest providing a user with an instructional device having selectively removable and repositionable markers for designating proper setup positioning and stance for the user to swing a golf club?

The examiner stated that "O'Brien discloses an instructional device having markers being adjustable for an individual user (fig 1, item 60,26,.)" Page 4, 18 October 2004 Office Action. First of all, as discussed above, the index 26 in O'Brien ('352) is not adjustable. While the O'Brien ('352) index 26 may be "located on the side of the hitting area toward the golfer" or "on the outside, i.e., whereby the golf ball is between the index and the golfer," (col. 6, lines 3-6) nowhere does O'Brien ('352) suggest that the index 26 is movable. Rather, the index 26 appears to be a fixed object that may be originally located in one of two places and that remains in its original location.

The O'Brien ('352) wedge 60 merely cants the rear foot and leg of a golfer (col. 7, lines 13-14; page 8, Applicant's Response 12 August 2004). Since the wedge 60 is not capable of designating proper setup positioning and stance for the user to swing a golf club, the wedge 60 is not a "selectively removable and repositionable [marker] for designating proper setup positioning and stance for the user to swing a golf club", as required by the applicant's claim 4. The claim 4 limitation "for designating proper setup positioning and stance for the user to swing a golf club" cannot be disregarded as "functional" by the examiner since it clearly limits the phrase "selectively removable and repositionable markers". See, for example, In re Pearson, 494 F.2d 1399 (C.C.P.A. 1974)(terms citing an intended use may be used to distinguish a new from an old composition).

The applicant respectfully asserts that the examiner has failed to meet the burden set forth in Clapp and Vaeck, and the applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejections of claim 4 and claims 5-6 which depend therefrom. Claims 4-6 are in condition for allowance, and allowance is respectfully requested.

**VII.** If claim 4 is obvious from the combination of O'Brien ('352) and Durso ('232), does the combination of McDevitt (US 6,500,075) and Florian ('124) render claim 5 unpatentable under 35 U.S.C. § 103(a)? Namely, does Florian ('124) disclose, teach, or suggest having a golf instructor position a mirror on a device in such a location as to teach a user to maintain a near-steady head while making practice swings with a golf club?

The examiner stated that "The step of placing the mirror on the mat surface would have been obvious to one of ordinary skill in the art in order to use the device in the proper fashion." Page 5, 18 October 2004 Office Action. This sentence may be understood in two ways.

The first meaning would be that the examiner did not fully appreciate how (where) the mirror was positioned. The applicant's claim 5 requires that the mirror be positioned "in such a location as to teach the user to maintain a near-steady head while making practice swings with the golf club". The examiner's statement does not address this claim element. Instead, it implies that since Florian ('124) discloses a mirror, the applicant's claim 5 is unpatentable. Florian ('124) does not disclose, teach, or suggest positioning a mirror "on [a] device in such a location as to teach the user to maintain a near-steady head while making practice swings with [a] golf club." The closest disclosure in Florian ('124) is that the Florian ('124) mirror allows a user to observe "whether his head remains in proper alignment by keeping his eyes parallel to the target line". Col. 3, lines 47-48. This clearly does not teach the user to maintain a near-steady head; instead, it teaches the user to move his head within a plane "parallel to the target line" and involves different mirror positioning.

The second meaning of the examiner's statement would be that a user would have to position the mirror in this way to use the applicant's device correctly. This is hindsight reasoning based on the applicant's disclosure instead of the prior art, directly contradictory to the requirements of Vaeck.

For the above reasons, and because the examiner has not specifically set forth how McDevitt ('075) discloses any of the elements of claim 5, the applicant respectfully asserts that the examiner has failed to meet the burden set forth in Clapp and Vaeck, and

the applicant respectfully requests the withdrawal of the 35 U.S.C. § 103(a) rejection of claim 5.

**VIII.** If claim 4 is obvious from the combination of O'Brien ('352) and Durso ('232), does the combination of McDevitt ('075) and Latella (US 5,839,968) render claim 6 unpatentable under 35 U.S.C. § 103(a)? Namely, does Latella ('968) disclose, teach, or suggest (1) providing a user with an instructional manual containing teaching methods corresponding to specific lessons taught by a golf instructor and (2) reinforcing a specific user stance and user club swing technique through teachings arranged within the manual outside the presence of the golf instructor; and does the prior art disclose, teach, or suggest (3) the selectively removable and repositionable markers for designating proper setup positioning and stance for the user to swing a golf club maintaining their positioning during transfer and subsequent setup of the instructional device?

The examiner stated that “The inclusion of instructions of how to use a device is well known in the art. Latella discloses the use of an instructional manual (28:25-33). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the method of including instructions as disclosed by Latella with the device of McDevitt in order to insure the device was used in the proper manner.” Page 5, 18 October 2004 Office Action.

The examiner does not address any of the following claim limitations: (1) manual “containing teaching methods corresponding to specific lessons taught by the golf instructor”; (2) “reinforcing a specific user stance and user club swing technique through teachings arranged within the manual outside the presence of the golf instructor”; (3) “the selectively removable and repositionable markers for designating proper setup positioning and stance for the user to swing a golf club maintaining their positioning during transfer and subsequent setup of the instructional device”. The examiner has only addressed “providing the user with an instructional manual”. None of these other three claim limitations are disclosed, taught, or suggested by the prior art, and none of these three limitations are addressed by the examiner. This is directly contradictory to the Vaeck requirement that the prior art reference (or references when combined) must teach

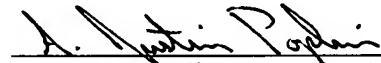
or suggest all of the claim limitations. As such, the applicant respectfully asserts that the 35 U.S.C. § 103(a) rejection of claim 6 cannot be supported and should be withdrawn, and withdrawal is respectfully requested.

**IX. Considering the terminal disclaimer filed concurrently with this Appeal Brief, is claim 13 in condition for allowance?**

The terminal disclaimer filed concurrently with this Appeal Brief complies with 35 U.S.C. § 253 and 37 C.F.R. § 1.321. As such, claim 13 should be in condition for allowance, and allowance is respectfully requested.

Respectfully submitted,

LATHROP & GAGE LLC

  
A. Justin Poplin, Reg. No. 53,476  
2345 Grand Boulevard, Suite 2800  
Kansas City, MO 64108  
Tel No: 816/460-5306  
Fax No: 816/292-2001

## APPENDIX - CLAIMS

1. (previously presented) A method of using a golf instructional device, said method comprising the steps of:
  - placing one or more selectively removable and repositionable foot positioning members onto a support mat surface to indicate proper placement of one or more feet of a user for swinging a golf club;
  - placing a selectively removable and repositionable club positioning member onto the support mat surface to indicate proper pre-swing body and club setup alignment;
  - placing a mirror adjacent the support mat surface, the mirror being sized and configured to indicate and maintain proper positioning of a user's eyes during a golf swing; and
  - having a user stand on the support mat surface and align one or more feet with the one or more foot positioning members, position the user's head such that the user can essentially only view their eyes in the mirror, and swing a golf club while the user visually observes any movement of their head in the mirror during at least a portion of the golf club practice swing.
2. (previously presented) The method of claim 1, further comprising the step of: adjusting the position of the one or more removable and repositionable foot positioning members, removable and repositionable club positioning member, or mirror on the support mat surface based on either a specific instructional lesson to be taught by a golf instructor, or on changes and/or improvements in the golf club swing of a user, such adjusting performed only by a golf instructor and not by the individual using the mat.

3. (original) The method of claim 1, further comprising the step of:  
providing the user with an instructional manual containing teaching methods  
corresponding to specific lessons taught by a golf instructor, such  
teachings arranged within the manual in a manner as to facilitate the user  
reinforcing specific pre-swing setup positioning and club swing techniques  
learned with the instructional device outside the presence of the golf  
instructor.
4. (previously presented) A method of providing golf instruction, said method  
comprising the steps of:  
providing a user with an instructional device having selectively removable and  
repositionable markers for designating proper setup positioning and stance  
for the user to swing a golf club, the positioning being customized and  
markers being adjustable for an individual user; and  
positioning a user in a proper stance by having a golf instructor position the  
selectively removable and repositionable markers on the device in such  
locations as to teach the user a proper setup position for swinging a golf  
club.
5. (original) The method of claim 4, further comprising the steps of:  
providing a mirror with the instructional device for monitoring the location of a  
user's eyes while making practice swings with the golf club;  
having a golf instructor position the mirror on the device in such a location as to  
teach the user to maintain a near-steady head while making practice  
swings with the golf club.

6. (previously presented) The method of claim 4, further comprising the step of: providing the user with an instructional manual containing teaching methods corresponding to specific lessons taught by the golf instructor, reinforcing a specific user stance and user club swing technique through teachings arranged within the manual outside the presence of the golf instructor, the selectively removable and repositionable markers for designating proper setup positioning and stance for the user to swing a golf club maintaining their positioning during transfer and subsequent setup of the instructional device .
7. (previously presented) A method of providing golf instruction in which a user makes practice golf club swings, comprising the steps of:
  - placing one or more removably positionable foot positioning markers onto a surface of a support mat to indicate proper positioning and alignment of one or more feet of a user for swinging a golf club;
  - placing a removably positionable club positioning marker onto the surface of the support mat to indicate proper pre-swing body and club setup alignment of the user;
  - placing a removably positionable mirror adjacent to the support mat surface sized and configured to indicate to the user a proper positioning of the user's eyes prior to swinging the golf club and during at least a portion of the user's practice swing; and
  - having a user stand on the support mat surface and align one or more feet with the one or more foot positioning markers, align a golf club shaft with the club positioning marker, position the user's head such that the user isolates the reflection of their eyes in the mirror, and swing a golf club while the user visually observes any excessive movement of their eyes in the mirror during at least a portion of the user's practice swing.

8. (previously presented) The method of claim 7, wherein the steps of placing the one or more removably positionable foot positioning markers onto the support mat surface, placing the removably positionable club positioning marker onto the support mat surface, and placing the removably positionable mirror adjacent to the support mat surface are performed by a golf instructor to provide the best body and golf club positioning setup for the user according to the physical characteristics of the user.

9. (original) The method of claim 7, further comprising the step of the golf instructor adjusting the position of at least one of the one or more foot positioning markers, the club positioning marker and mirror on the surface of the support mat based on one of:

the golf instructor observing the user's flexibility increase with practice; and  
the golf instructor observing the user's individual physical swing characteristics becoming apparent when such swing characteristics were not previously apparent.

10. (original) The method of claim 7, wherein the step of the user visually observing any excessive movement of their eyes in the mirror during at least a portion of the user's practice swing comprises the user visually observing any movement of their eyes in the mirror prior to swinging the golf club and during a portion of the user's practice swing through simulated impact with a golf ball.

11. (previously presented) The method of claim 7, further comprising the step of placing a golf ball marker on the support mat to indicate the proper setup position of a golf club head held by the user.

12. (original) The method of claim 7, further comprising the step of placing a wedge onto the surface of the support mat for the user to place one foot thereon to aid in training the user to maintain a near-stationary back leg during the entire backswing.

13. (previously presented) A method of providing golf instruction, said method comprising the steps of:

providing a user with an instructional device having selectively removable and repositionable markers for designating proper setup positioning and stance for the user to swing a golf club, the positioning being customized and markers being adjustable for an individual user;

providing a mirror with the instructional device for monitoring the location of a user's eyes while making practice swings with the golf club;

positioning a user in a proper stance by having a golf instructor position the selectively removable and repositionable markers on the device in such locations as to teach the user a proper setup position for swinging a golf club,

having a golf instructor position the mirror on the device in such a location as to teach the user to maintain the stance and a near-steady head while making practice swings with the golf club, the mirror being sized and configured such that an incorrect stance will cause the user to not see his reflection;

providing the user with an instructional manual containing teaching methods corresponding to specific lessons taught by the golf instructor, and reinforcing a specific user stance and user club swing technique through teachings arranged within the manual outside the presence of the golf instructor, the selectively removable and repositionable markers for designating proper setup positioning and stance for the user to swing a golf club maintaining their positioning during transfer and subsequent setup of the instructional device.

## **APPENDIX – EVIDENCE**

## **APPENDIX – RELATED PROCEEDINGS**